

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86041474
LAW OFFICE ASSIGNED	LAW OFFICE 117
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Request for reconsideration</p> <p>Number - 86041474</p> <p>Mark - Necklette</p> <p>‘The examining attorney maintains that the mark NECKLETTE is descriptive ...’</p> <p>The applicant contends that “necklette” is not in the dictionary. The fact that a descriptive word or term is not found in the dictionary is not controlling on the question of registrability. In re Gould Paper Corp.,</p> <p>834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b).</p> <p>As stated above, the determination of whether a mark is descriptive is in relation to the applicant’s goods, not in the abstract. The applicant identified necklaces and bracelets and the examining attorney attached evidence from several different websites which show that consumers call <u>novel necklaces</u> that can be used as <u>bracelets, necklettes.</u>’</p> <p>We believe that with the following that the mark is ‘Suggestive’.</p> <p>A mark is suggestive, and therefore registrable, without evidence of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion</p>	

on the nature of the goods or services. “[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the mark indicates, the term is suggestive rather than merely descriptive.” In re Tennis in the Round, Inc., 199 USPQ 496, 497 (TTAB 1978).

One must assume that prospective consumers will encounter the term in relation to the identified services and determine whether those consumers will understand the term to convey information about the services.

(Consequently, an applicant can overcome a merely descriptive refusal under Section 2(e)(1) by making well-formed arguments that a multi-stage reasoning process is needed to associate the mark with the goods or services sold under the mark.)

The examining attorney has stated ... ‘The applicant identified necklaces and bracelets and the examining attorney attached evidence from several different websites which show that consumers call **novel necklaces** that can be used as **bracelets, necklettes.**’

With this interpretation of the mark, we now see and should have made clear in our last response that we were not using necklettes as a concatenation for a dual purpose piece of jewelry. What is being attempted is to create a unique branding for the applicant’s necklaces and bracelets. We did confirm that the mark is not in use by anyone so there would be no confusion; that it is not a dictionary word, and showed that it was given novel use in other classes.

Given that the consumer knows the nature of the goods it should only take a modicum of reasoning to see this as a novel mark for both bracelets and necklaces. Through time this would become branded to the applicant’s offerings.

Paul Leonhardt, Serial No. 78666879 (TTAB 2008)

IP Carrier Consulting Group, Serial No. 78542726, 78542734, (TTAB 2007).

Callaway Vineyard & Winery v. Endsley Capital Group, Inc., Opposition No. 121,583, (TTAB 2002).

NEW ATTORNEY SECTION

NAME	David M. Goodson
INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER	TTA15481

STREET	313 Fourth Street
CITY	Hinsdale
STATE	Illinois
ZIP/POSTAL CODE	60521
COUNTRY	United States
PHONE	6308877778
FAX	6306546085
EMAIL	dgadavid@comcast.net
AUTHORIZED EMAIL COMMUNICATION	Yes
CORRESPONDENCE SECTION	
ORIGINAL ADDRESS	CREATIONS BY SHERRY LYNN, LLC CREATIONS BY SHERRY LYNN, LLC 14 WITTE PL WEST ORANGE New Jersey (NJ) US 07052-6618
NEW CORRESPONDENCE SECTION	
NAME	David M. Goodson
INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER	TTA15481
STREET	313 Fourth Street
CITY	Hinsdale
STATE	Illinois
ZIP/POSTAL CODE	60521
COUNTRY	United States
PHONE	6308877778
FAX	6306546085
EMAIL	dgadavid@comcast.net;john@quant0.com;trademark@thoughtstopaper.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/David M. Goodson/

SIGNATORY'S NAME	David M. Goodson
SIGNATORY'S POSITION	Attorney of Record
SIGNATORY'S PHONE NUMBER	6308877778
DATE SIGNED	11/24/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Nov 24 13:29:34 EST 2014
TEAS STAMP	USPTO/RFR-98.223.88.190-2 0141124132934968971-86041 474-500fe8fbb563ae3eedc84 1338394ccd09acb69ea238535 a13c8b469cc802ff63f-N/A-N /A-20141124132049484520

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86041474** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Request for reconsideration

Number - 86041474

Mark - Necklette

‘The examining attorney maintains that the mark NECKLETTE is descriptive ...’

The applicant contends that “necklette” is not in the dictionary. The fact that a

descriptive word or term is not found in the dictionary is not controlling on the question of registrability. In re Gould Paper Corp.,

834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b).

As stated above, the determination of whether a mark is descriptive is in relation to the applicant's goods, not in the abstract. The applicant identified necklaces and bracelets and the examining attorney attached evidence from several different websites which show that consumers call novel necklaces that can be used as bracelets, necklettes.'

We believe that with the following that the mark is 'Suggestive'.

A mark is suggestive, and therefore registrable, without evidence of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. "[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the mark indicates, the term is suggestive rather than merely descriptive." In re Tennis in the Round, Inc., 199 USPQ 496, 497 (TTAB 1978).

One must assume that prospective consumers will encounter the term in relation to the identified services and determine whether those consumers will understand the term to convey information about the services.

(Consequently, an applicant can overcome a merely descriptive refusal under Section 2(e)(1) by making well-formed arguments that a multi-stage reasoning process is needed to associate the mark with the goods or services sold under the mark.)

The examining attorney has stated ... 'The applicant identified necklaces and bracelets and the examining attorney attached evidence from several different websites which show that consumers call **novel necklaces** that can be used as **bracelets, necklettes**.'

With this interpretation of the mark, we now see and should have made clear in our last response that we were not using necklettes as a concatenation for a dual purpose piece of jewelry. What is being attempted is to create a unique branding for the applicant's necklaces and bracelets. We did confirm that the mark is not in use by anyone so there would be no confusion; that it is not a dictionary word, and showed that it was given novel use in other classes.

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Callaway Vineyard & Winery v. Endsley Capital Group, Inc., Opposition No. 121,583, (TTAB 2002).

ATTORNEY ADDRESS

Applicant proposes to amend the following:

Proposed:

David M. Goodson, having an address of
313 Fourth Street Hinsdale, Illinois 60521

United States

dgadavid@comcast.net

6308877778

6306546085

The attorney docket/reference number is TTA15481 .

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

CREATIONS BY SHERRY LYNN, LLC

CREATIONS BY SHERRY LYNN, LLC

14 WITTE PL

WEST ORANGE

New Jersey (NJ)

US

07052-6618

Proposed:

David M. Goodson, having an address of
313 Fourth Street Hinsdale, Illinois 60521

United States

dgadavid@comcast.net;john@quant0.com;trademark@thoughtstopaper.com

6308877778

6306546085

The attorney docket/reference number is TTA15481 .

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /David M. Goodson/ Date: 11/24/2014

Signatory's Name: David M. Goodson

Signatory's Position: Attorney of Record

Signatory's Phone Number: 6308877778

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: David M. Goodson
313 Fourth Street
Hinsdale, Illinois 60521

Serial Number: 86041474

Internet Transmission Date: Mon Nov 24 13:29:34 EST 2014

TEAS Stamp: USPTO/RFR-98.223.88.190-2014112413293496

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